

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB MAY 17, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re TACC International Corporation, assignee of Columbia  
Cement Co., Inc.<sup>1</sup>

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Serial No. 75/251,075

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James D. Zalewa of Leydig, Voit & Mayer, Ltd. for  
applicant.

Yong Oh (Richard) Kim, Trademark Examining Attorney, Law  
Office 115 (Tomas Vlcek, Managing Attorney).

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Before Hanak, Chapman and Wendel, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant has filed an application to register the  
mark KWIKSTIK for "premixed adhesive foam cements, contact  
cements and flooring adhesives for industrial and  
commercial purposes only"<sup>2</sup> in Class 1.<sup>3</sup>

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<sup>1</sup> The assignment is recorded with the Assignment Branch of this  
Office at reel 1631, frame 0750.

<sup>2</sup> Application Serial No. 75/251,075, filed March 4, 1997, based  
on a claimed first use date of November 1951.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the registered mark QUICK STICK for "wall size and cold water paste powder,"<sup>4</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

We reverse the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Food, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

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<sup>3</sup> In light of the Examining Attorney's comments in his brief on the case, the classification of the goods has been changed from Class 4 to Class 1.

<sup>4</sup> Registration No. 758,634, issued under Section 2(f) of the Trademark Act on October 22, 1963, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed. The claimed date of first use is January 1, 1912.

Turning first to the marks, it is clear that the marks are similar in sound, meaning and commercial impression. However, there is no question that both marks are highly suggestive of the parties' respective goods. In fact, the registered mark issued pursuant to Section 2(f) of the **Trademark Act**, indicating the mark is descriptive of registrant's goods. Thus, the scope of protection of such marks is not broad. See *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295 (CCPA 1958). See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:73 (4th ed. 2000).

Turning to the involved goods, the Board must determine the issue of likelihood of confusion on the basis of the goods as identified in the application and the registration. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). While applicant's identification of goods refers to adhesives and cements and registrant's identification refers to wall size and paste, it does not necessarily follow that all adhesives and pastes are related, or that the channels of trade are the same or overlap. If the relatedness of the goods and/or the trade channels are not otherwise clear from the record, through, for example, the identifications of goods, the

specimens of record, and/or applicant's statements, then the Examining Attorney carries the burden of establishing a prima facie case as to such issues.

In this case, we find a reasonable reading of applicant's identification of goods to be that both the word "premixed" and the phrase "for industrial and commercial purposes only" relate to all three types of products (adhesive foam cements, contact cements and flooring adhesives) recited therein. Further, we find a reasonable reading of registrant's identification of goods to be that at least the first portion "wall size" relates to wall papering size or adhesive or other adhesives used for walls. Applicant's specimens of record are labels showing flooring adhesive, which would not be an adhesive utilized as wall adhesive.<sup>5</sup>

In support of his position as to the relatedness of the respective goods, the Examining Attorney argues that

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<sup>5</sup> Applicant submitted with its reply brief a photocopy of a page from the website of the cited registrant's successor-in-interest referring to the acquisition of "wall covering primers and adhesives" to show that registrant's goods are distinct from applicant's line of adhesives and cements. Normally, material submitted for the first time with applicant's reply brief would be excluded as untimely submitted. See Trademark Rule 2.142(d), and TBMP §1207. However, in this case, the Examining Attorney raised the issue of the assignment of the cited registration for the first time in his appeal brief, and the Examining Attorney used the information for a substantive argument with respect to the nature of the goods. Thus, it is appropriate for us to accept and consider the photocopy website page in our decision.

"both are adhesive preparations used for flooring and construction" (final Office action, p. 2). The Examining Attorney submitted several third-party registrations, each of which issued on the basis of use in commerce, to demonstrate that adhesives, cements and pastes for use in both flooring and wallcovering applications may well emanate from a single source. Some of these third-party registrations show that the same entity offers a variety of adhesives, cements and pastes under the same mark. However, the third-party registrations do not demonstrate that the various adhesives, cements and/or pastes are for related purposes. (See, e.g., Registration No. 427,173, for "adhesives in solid and liquid form, namely, rubber cement, vulcanizing cement, repair gum and adhesive cements embodying natural and synthetic resins"; and Registration No. 800,553 for "glues, rubber cements, synthetic rubber-resin type adhesives, contact cements, epoxy cements and adhesives, and sealer type adhesive cements.")

Based on the record before us, we simply do not know enough about these specific goods, "wall size and cold water paste powder" for registrant and "premixed adhesive foam cements, contact cements and flooring adhesives for industrial and commercial purposes only" for applicant. That is, we cannot tell from the record whether these goods

are sold only to specialized consumers (e.g., separate contractors), or whether the goods (adhesives/pastes) are intended for separate uses, such as wall papering, or flooring or general use. Applicant has coherently argued that these goods, as identified, relate to specific and different types of adhesives, which are sold through differing channels of trade to different purchasers. The Examining Attorney has not met his burden of establishing the relatedness of the goods as a factor in determining the ultimate issue of likelihood of confusion.<sup>6</sup> See *Borden, Inc. v. PCI Industries, Inc.*, 198 USPQ 446 (TTAB 1978) (wherein RES-AC for adhesives was found not confusingly similar to RESLAC for plasticols).

Our decision is bolstered by the fact that applicant first registered its mark in 1957 (Registration No. 640,523 for "adhesive foam cements," cancelled for failure to renew); and that the cited registrant's mark, which issued in 1962 and applicant's previously registered mark apparently coexisted for decades without a problem.

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<sup>6</sup> We recognize that doubt on the ultimate issue of likelihood of confusion is resolved in favor of the cited registrant. However, in this case the doubt we have relates to the factual issues of relatedness of the goods and the trade channels.

**Ser. No.** 75/251075

Decision: The refusal under Section 2(d) is reversed.

E. W. Hanak

B. A. Chapman

H. R. Wendel  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board